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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,207	12/07/1999	JEREMY VANDER WOUDE	MPATENT.160A	7416

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EXAMINER

KUMAR, PANKAJ

ART UNIT	PAPER NUMBER
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2631

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/457,207

Applicant(s)

WOUDE, JEREMY VANDER

Examiner

Pankaj Kumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The office traverses applicant's argument the Simmons's invention and applicant's invention are different because the modem in Simmons communicates with a computer via a RS232 interface while applicant is claiming that its modem is inside the computer (page 2 last paragraph). Just because in Simmons the modem and computer are connected via a RS-232 interface does not negate the fact that that the modem to be placed inside the computer. Besides, it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Also, there is no new and unexpected result between having the modem is inside or outside of the computer.

2. The office traverses applicant's argument the Simmons's invention and applicant's invention are different because Simmons does not test a modem within a computer but rather tests a modem using a computer to analyze data from the test (page 2 last paragraph). Since Simmons is testing a modem using a computer, placing a modem inside a computer only requires routine skill in the art since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Also, there is no new and unexpected result between having the modem is inside or outside of the computer.

3. The office traverses applicant's argument the Simmons's invention and applicant's invention are different because Simmons does not perform any analysis or reporting of analysis

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results (page 3 first paragraph). In Simmons, the output of fig. 8B 855 is the ch. 2 out in fig. 3 which is the channel 2 out in fig. 2A which eventually becomes output 209 which is also designated as 125 in figs. 2A and fig. 1. A version of this output is output from network simulator 100 in fig. 1. Fig. 1A shows that 100 is connected to the modem under test and eventually to the PC. As the data is flowing, analysis is being performed and since the data changes as it flows between components, analysis reporting is being performed. Also, since testing is occurring, Simmons is analyzing and reporting the analysis since these functions are part of testing.

4. The office traverses applicant's argument the Simmons's invention and applicant's invention are different because Simmons does not show a communication port. It is inherent for ports to exist in order to connect the different elements of Simmons.

5. The office traverses applicant's argument the Simmons's invention and applicant's invention are different because Simmons does not show a portable modem coupled to a computer. Simmons shows a modem coupled to a computer in fig. 1A. It has been held that making an old device portable or movable without producing any new and unexpected result involves only routine skill in the art. In re Lindberg, 93 USPQ 23 (CCPA 1952).

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., 'separate connection to a separate port' on page 3 last paragraph) are not recited in the rejected claim(s).

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Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. Response to Amendment

a. Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

9. A person shall be entitled to a patent unless –

10. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Simmons et al. USPN 6195414B1.

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13. As per claim 1, Simmons teaches a device (Simmons fig. 1: 100) for testing the operation of a modem (Simmons fig. 1a: 170) in a computer (Simmons fig. 1a: 180), the device comprising:

14. a case (inherent for 100 in fig. 1 of Simmons to be within a case to reduce the effect of temperature, humidity, liquid spilling and other effects of the environment); a first communication port attached to the case (Simmons fig. 1: 150) and configured to receive signals from a modem in a computer (Simmons fig. 1: 100 receives signals from 170); and a signal reporting circuit (Simmons fig. 8b: 855, teaches outputting sample and thus this is equivalent to reporting the signal) located within the case (Simmons fig. 3 teaches channel 2 processing transmit direction which is what fig. 8 was discussing and fig. 3 is a DSP 220 which is in fig. 2a which is in 200 and in fig. 1a) and coupled to the first communication port (Simmons fig. 8 is a flow chart of fig. 3 which is coupled to fig. 1's 150 communication port via other links), the signal reporting circuit configured to test the transmit capability of the modem in the computer (fig. 8a "transmit direction process"; the output of fig. 8B 855 is the ch. 2 out in fig. 3 which is the channel 2 out in fig. 2A which eventually becomes output 209 which is also designated as 125 in figs. 2A and fig. 1. A version of this output is output from network simulator 100 in fig. 1. Fig. 1A shows that 100 is connected to the modem under test and eventually to the PC.).

15. As per claim 2, the device of claim 1 further comprising a second communication port (Simmons fig. 1: 10) coupled to the signal reporting circuit (Simmons fig. 8b: 855 teaches outputting sample and thus this is equivalent to reporting the signal; fig. 8 is a flow chart of fig. 3 which is coupled to fig. 1's 10 communication port via other links) and configured to

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communicate with the computer (fig. 8a “transmit direction process”; the output of fig. 8B 855 is the ch. 2 out in fig. 3 which is the channel 2 out in fig. 2A which eventually becomes output 209 which is also designated as 125 in figs. 2A and fig. 1. A version of this output is output from network simulator 100 in fig. 1. Fig. 1A shows that 100 is connected to the modem under test and eventually to the PC.).

16. See prior action for the rejections to the other claims.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pankaj Kumar whose telephone number is (703) 305-0194. The examiner can normally be reached on Monday through Thursday after 8AM to after 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H. Pham can be reached on (703) 305-4378. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

PK

October 31, 2002


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600 10/31/02